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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/882,721	06/15/2001	Takeshi Kikuchi	393032025900	9175

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MORRISON & FOERSTER, LLP  
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LOS ANGELES, CA 90013-1024

EXAMINER

NGUYEN, PHUOC H

ART UNIT PAPER NUMBER

2143

DATE MAILED: 04/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/882,721

Applicant(s)

KIKUCHI ET AL.

Examiner

Phuoc H. Nguyen

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**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --****Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1)  Responsive to communication(s) filed on January 5, 2006.
- 2a)  This action is FINAL.                      2b)  This action is non-final.
- 3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4)  Claim(s) 1-9, 17-19, 21-27, 37, 39-45, 65-67, 70-74 and 115-117 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5)  Claim(s) \_\_\_\_\_ is/are allowed.
- 6)  Claim(s) 1-9, 17-19, 21-27, 37, 39-45, 65-67, 70-74 and 115-117 is/are rejected.
- 7)  Claim(s) \_\_\_\_\_ is/are objected to.
- 8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9)  The specification is objected to by the Examiner.
- 10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a)  All    b)  Some \*    c)  None of:
1.  Certified copies of the priority documents have been received.
  2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Response to Amendment*

1. This office action is in response to the amendment filed on January 5, 2006. Applicant amended claims 1, 2, 4, 6, 7, and 10. Amendment filed on November 24, 2004 have been entered and made of record. Therefore, pending claims 1-9, 17-19, 21-27, 37, 39-45, 65-67, 70-74, and 115-117 are presented for further consideration and examination.

### *Response to Arguments*

2. Applicant's arguments with respect to claims 1, 18, 19, 37, 65, and 70 have been considered but are moot in view of the new ground(s) of rejection.

### *Claim Rejections - 35 USC § 103*

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 1-2,5,7-9, 17-19, 23-27, 37, 41, 43-45, 65, 70-72,74, and 115-117 are rejected under 35 U.S.C. 103(a) as being unpatentable over Katz et al. (Hereafter, Katz) U.S. Patent 5,926,624 in view of Hannula U.S. Patent 6,941,270.

5. Regarding claims 1 and 19, Katz discloses a content distribution system (Figure 10) which comprises a portable terminal (e.g. playback device, 212), a distribution server (e.g.

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Library Server, 260) capable of communicating with said portable terminal (e.g. Figure 10, 212 communicates with 260), and a client terminal (e.g. client system 214 or 814) capable of communicating with said distribution server and in which a content item is distributed from said distribution server to said portable terminal by use of said client terminal (e.g. Figure 10; communication between 212, 214, 240, and 260), wherein said distribution server comprises: content distribution means for distributing the content item to said portable terminal in response to a request from said client terminal (e.g. server response to the request for digital information from the client device to the portable terminal 212 or 226; col. 13 lines 25-58); said client terminal comprises: content request means for requesting said distribution server to distribute the content item to said portable terminal (col. 13 lines 19-25); and said portable terminal comprises: content execution means for performing operation on the basis of the distributed content item (col. 13 lines 25-58); however, Katz does not clearly disclose charging a fee to a user of said portable terminal, when the content item is distributed to said portable terminal.

Hunnula teaches charging a fee to a user of said portable terminal, when the content item is distributed to said portable terminal (Figure 3; col. 6 lines 55 through col. 7 lines 8; and col. 7 lines 31-62).

It would have been obvious to one of the ordinary skill in the art at the time of the invention was made to incorporate Hunnula's teaching into Katz's teaching to incorporate charging a fee to a user of said portable terminal, when the content item is distributed to said portable terminal which provide an efficient way to insure entity having the property rights in the content shall be properly credited for the additional user's use of the content.

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6. Regarding claims 2, and 71, Katz further discloses distribution server comprises: trial-content distribution means for distributing, in response to a request from said client terminal, a trial content item to said client terminal, the trial content item being used at said client terminal in trial use of the content item to be distributed to said portable terminal (e.g. server response to the request for digital information (for instance preview clips) from the client device to the portable terminal 212 or 226), and said client terminal comprises: trial-content request means for requesting said distribution server to distribute the trial content item, and trial means for using on a trial basis the trial content item distributed from said distribution server (col. 8 lines 7-12; and col. 13 lines 19-58).

7. Regarding claims 5, 23, and 41, Katz further discloses content request means of said client terminal comprises portable-terminal-specifying-data transmission means for transmitting to said distribution sever data for specifying said portable terminal, and said content distribution means of said distribution server comprises direct distribution means for distributing the content item directly to said portable terminal specified by the data transmitted by said portable-terminal-specifying-data transmission means (Figures 2, 8 and 10; col. 13 lines 19-64 and col. 16 last paragraph through col. 17 1<sup>st</sup> paragraph).

8. Regarding claims 7,25,43,74, and 115-117, Katz further discloses client terminal comprises type-specifying-data transmission means for transmitting to said distribution server data which specify a type of said content execution means of said portable terminal, and said content distribution means of said distribution server distributes to said portable terminal a content item corresponding to the data which specify the type of said content execution means of said portable terminal (col. 13 lines 19-64).

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9. Regarding claims 8,26, and 44, Katz further discloses distribution server comprises a database which stores a content item (Figure 2; Digital information files 262); and said content distribution means of said server processes the content item stored in said database in accordance with the data which specify the type of said content execution means of said portable terminal and distributes the processed content item to said portable terminal as the requested content item (col. 8 2<sup>nd</sup> paragraph; and col. 13 lines 19-64).

10. Regarding claims 9,27, and 45, Katz further discloses distribution server comprises a database which stores a plurality of content items (Figure 2; Digital information files 262) corresponding to types of said content execution means of said portable terminal, and said content distribution means of said distribution server selects one content item from the plurality of content items stored in said database in accordance with the data which specify the type of said content execution means of said portable terminal and distributes the selected content item to said portable terminal (col. 8 2<sup>nd</sup> paragraph; and col. 13 lines 19-64).

11. Regarding claim 17, Katz further discloses a different trial content item is distributed depending on the type of said content execution means of said portable terminal (col. 13 lines 36-40).

12. Regarding claim 18, Katz further discloses distribution server comprises charging means charges a predetermined fee as said fee to the user of said portable terminal when the content item is distributed, and charges a fee lower than the predetermined fee to the user of said portable terminal when the trial content item is distributed (col. 11 1<sup>st</sup> paragraph).

13. Regarding claim 37, Katz discloses a distribution server capable of communicating with a portable terminal including content execution means for performing operation on the basis of a

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distributed content item and with a client terminal (Figure 2 and 10), comprising: content distribution means for distributing the content item to said portable terminal in response to a request from said client terminal (e.g. server response to the request for digital information from the client device to the portable terminal 212 or 226; col. 13 lines 25-58).

14. Regarding claim 65, Katz further discloses a portable terminal to which a content item is distributed from a distribution server by use of a client terminal capable of communicating with said distribution server (Figure 10), comprising: content receiving means for receiving the content item which is transmitted from said distribution server in response to a request from said client terminal, and content execution means for performing operation on the basis of the received content item (col. 13 lines 19-58)

15. Regarding claim 70, Katz discloses a computer-readable recording medium on which is recorded a program applied to a client computer capable of communicating with a distribution server which distributes a content item to a portable terminal including content execution means for performing operation on the basis of the distributed content item, said program comprising: content request processing for requesting said distribution server to distribute the content item to said portable terminal (col. 13 lines 19-58).

16. Regarding claim 72, Katz further discloses content request processing comprises portable-terminal-specifying-data transmission processing for transmitting to said distribution server data for specifying said portable terminal (Figures 2, 8 and 10; col. 13 lines 19-64 and col. 16 last paragraph through col. 17 1<sup>st</sup> paragraph).

*Claim Rejections - 35 USC § 103*

17. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

18. Claims 3,4,6,21,22,39,40,42,66,67, and 73 are rejected under 35 U.S.C. 103(a) as being unpatentable over Katz in view of Dodd U.S. Patent 6,633,849.

19. Regarding claims 3,4,21,22,39,40,66, and 73, Katz discloses a content distribution system which comprises a portable terminal, a distribution server capable of communicating with said portable terminal, and a client terminal capable of communicating with said distribution server and in which a content item is distributed from said distribution server to said portable terminal by use of said client terminal; however, Katz fails to teach distribution server comprises: URL mailing means for sending an electronic mail to said portable terminal in order to transmit to said portable terminal a URL of a download page for downloading the content item, and download means for distributing the content item to said portable terminal, in response to access to the URL, by said portable terminal, and said portable terminal comprises content obtaining means for accessing the URL of the download page transmitted from said distribution server in order to download the content item.

Dodd teaches distribution server comprises: URL mailing means for sending an electronic mail to said portable terminal in order to transmit to said portable terminal a URL of a download page for downloading the content item, and download means for distributing the



content item to said portable terminal, in response to access to the URL, by said portable terminal, and said portable terminal comprises content obtaining means for accessing the URL of the download page transmitted from said distribution server in order to download the content item, and content request means of said client terminal comprises address transmission means for transmitting to said distribution server a mail address of said portable terminal to which the URL of the download page is to be transmitted by means of an electronic mail (Figure 5; and col. 11 lines 41 through col. 12 lines 13).

It would have been obvious to one of the ordinary skill in the art at the time of the invention was made to incorporate to Dodd's teaching into Katz's method to provide the intended recipient email address and send an URL link to the intended recipient for downloading the content, because by making extensive use of e-mail because it is fast, flexible, and reliable.

20. Regarding claims 6,24,42, and 67, Katz discloses the data transmitted by said portable-terminal-specifying-data transmission means of said client terminal, and direct distribution means of said distribution server transmits the content to the portable terminal; however, Katz fails to teach the use of mail address of the portable terminal to transmit the content item.

Dodd teaches distribution server use of mail address of the portable terminal to transmit the content item (Figure 5).

It would have been obvious to one of the ordinary skill in the art at the time of the invention was made to incorporate to Dodd's teaching into Katz's method to provide the intended recipient email address and send an URL link to the intended recipient for downloading the content, because by making extensive use of e-mail because it is fast, flexible, and reliable.

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*Conclusion*

21. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

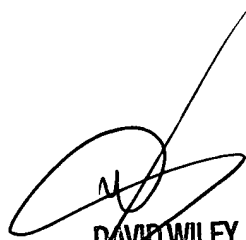
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phuoc H. Nguyen whose telephone number is 571-272-3919. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wiley can be reached on 571-272-3923. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Phuoc H Nguyen  
Examiner  
Art Unit 2143

March 28, 2006

  
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